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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/554,917	04/27/2007	Vicki S. Elliott	039386-2277	9780
23428 7590 10/16/2009 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007				
EXAMINER				
SWOPE, SHERIDAN				
ART UNIT		PAPER NUMBER		
1652				
MAIL DATE		DELIVERY MODE		
10/16/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/554,917

Applicant(s)

ELLIOTT ET AL.

Examiner

SHERIDAN SWOPE

Art Unit

1652

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 7, 11, 14-20, 23, 26-32, 34, 36, 44-55 and 142-144 is/are pending in the application.
- 4a) Of the above claim(s) 1, 2, 11, 14-20, 23, 26-32, 34, 36 and 44-55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3, 4, 6, 7, and 142-144 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-846)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicants' filing of September 2, 2009, in response to the action of June 3, 2009, is acknowledged. It is acknowledged that Claim 5, 12, and 13 have been cancelled, Claims 3, 4, 6, 7, 14, 16, 28, and 29 have been amended, and Claims 142-144 have been added.

Claims 1-4, 6, 7, 11, 14-20, 23, 26-32, 34, 36, 44-55, and 142-144 are pending. The elected invention is directed to a polynucleotide encoding the polypeptide of SEQ ID NO: 13. Claims 1, 2, 11, 14-20, 23, 26-32, 34, 36, and 44-55 were previously withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions. Claims 3, 4, 6, 7, and 142-144 are hereby examined.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Utility

Rejection of Claims 3, 4, 6, and 7 under 35 U.S.C. 101 because the claimed invention lacks patentable utility, for the reasons explained in the prior action, is maintained. Claims 142-144 are herein rejected under 35 U.S.C. 101/utility, for the same reasons. In support of their request that said rejection be withdrawn, Applicants provide the following arguments.

(A) Applicants provide a review of "credibility", as discussed in M.P.E.P. § 2107.II.

(B) While being useful for therapeutics, diagnostics, antibody production and identification of modulators, the claimed sequences are also useful as markers for brain tissue. Tissue specific expression was determined by microarray analysis, and "[t]he expression of SEQ ID NO: 56 was increased by at least two-fold in brain as compared to the reference sample." (pg

102, lines 3-4 and 17-18). The specification states that "[t]issue contributing to the reference sample... [included] brain..., heart..., kidney..., lung..., placenta..., small intestine..., spleen... stomach...testis...and uterus." (pg 102, lines 5-8). Thus, SEQ ID NO: 56 has a specific, substantial and credible utility as a marker for brain tissue.

These arguments are not found to be persuasive for the following reasons.

(A) Reply: Said discussion is acknowledged.

(B) Reply: The reasons use for therapeutics, diagnostics, antibody production and identification of modulators does not provide a patentable utility is explained in the prior action.

The skilled artisan would not conclude that SEQ ID NO: 56 is a marker for brain tissue based on the specification disclosing that SEQ ID NO: 56 has a mere two-fold higher expression in brain than in the reference sample.

For these reasons and those explained in the prior action, Claims 3, 4, 6, 7, and 142-144 are rejected under 35 U.S.C. 101 because the claimed invention lacks a specific, substantial, and credible patentable utility.

Claims 3, 4, 6, 7, and 142-144 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well-established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Allowable Subject Matter

No claims are allowable.

Applicant's amendment necessitated any new grounds of rejection presented in this Office action. Any new references were cited solely to support rejection(s) based on amendment

or rebut Applicants' arguments. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Regarding filing an Appeal, Applicants are referred to the Official Gazette Notice published July 12, 2005 describing the Pre-Appeal Brief Review Program.

Final Comments

To insure that each document is properly filed in the electronic file wrapper, it is requested that each of amendments to the specification, amendments to the claims, Applicants' remarks, requests for extension of time, and any other distinct papers be submitted on separate pages. It is also requested that the serial number of the application and date of amendment be referenced on every page of the response.

It is also requested that Applicants identify support, within the original application, for any amendments to the claims and specification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheridan L. Swope whose telephone number is 571-272-0943. The examiner can normally be reached on M-F; 9:30-7 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published application may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/SHERIDAN SWOPE/
Primary Examiner, Art Unit 1652